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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,683	04/21/2000	Lawrence Xavier Webb, M.D.	F. 003	6497

7590

01/16/2002

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EXAMINER

MANTIS MERCADER, ELENI M

ART UNIT

PAPER NUMBER

3737

DATE MAILED: 01/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,683

Applicant(s)

WEBB, M.D., LAWRENCE XAVIER

Examiner

Eleni Mantis Mercader

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 29 is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection. Claims 28 and 29 are allowable.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosby'985 in view of 3MiobanDrapes (1987) both of record.

Mosby'985 teaches all the features of the instant invention including a conforming grid made of pliable compliant plastic sheet like material allowing for marking with radiopaque and visible lines, letters and numbers, conforming to the outline of the subject matter and becoming its own standard reference used in biopsy or **biopsy surgery** permitting the entrance of a biopsy needle (see col. 6, lines 38-47, col. 7, lines 1-10 and all claims referring to biopsy surgery and perforation of the plastic with stylet and biopsy needles). Since Mosby'985 is teaching use of the plastic grid during surgery it is inherent that precautions are taken to avoid infection, however, Mosby'985 does not in particular teach the use of plastic made of iodophor as drapes. 3MiobanDrapes (1987) teach the use of plastic iodophor adhesive drapes providing for sterile conditions. It would have been obvious to one skilled in the art at the time that the invention was made to have utilized the sterile iodophor drapes in the invention of Mosby'985 as the pliable

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compliant plastic sheet like material allowing for marking with radiopaque and visible lines, letters and numbers, conforming to the outline of the subject matter, in order to provide for sterile conditions and fight skin bacteria during the surgery as taught in 3MiobanDrapes (1987, page 3/4).

Furthermore, Mosby'985 teaches a localization procedure and device which provides for complete utilization of a maximum of two planes of evaluation (col. 3, lines 58-62).

Allowable Subject Matter

4. Claims 28-29 are allowed.

5. As stated to the applicant's representative, the proposed amendment with respect to the apparatus claims of "increasing the size of said opening in said drape during surgery," would not render the claims allowable because it is only a functional limitation not further limiting the apparatus as disclosed by Mosby'985. Upon further consideration, the proposed language as stated in the proposed amendment would not make the proposed method claims allowable either, because Mosby'985 teaches increasing the opening by inserting the localization or biopsy needle through or adjacent to the stylet (see col. 7, lines 1-10).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kormos et al.'890 teach a magnetic resonance stereotactic surgery with exoskeleton tissue stabilization.

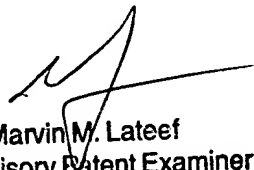
Gueziec et al.'495 teach an interactive pre-operative surgical plan.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Wed. - Wed., 7:00 a.m.-5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703 308-7635. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-0758 for regular communications and 703 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0858.



Marvin M. Lateef
Supervisory Patent Examiner
Group 3700



EMM
January 8, 2002